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Anand Subramanian

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANAND SUBRAMANIAN, JEREMY STERNS,
and SHANTHINI RAJENDRAM

Appeal 2010-002280
Application 10/001,772
Technology Center 3600

Oral Hearing Held: September 14, 2010

Before HUBERT C. LORIN, JEAN R. HOMERE and
BIBHU R. MOHANTY, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

THOMAS J. BEAN, ESQ.
Darby & Darby, PC
Church Street Station
New York, New York 10008-0770

1 The above-entitled matter came on for hearing on Tuesday,
2 September 14, 2010, commencing at 2:05 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,
4 before Jon Hundley, Notary Public.

5 THE CLERK: Calendar No. 14, Appeal No. 2010-002280. Mr.
6 Bean.

7 JUDGE LORIN: Okay. Thank you so much.

8 All right. Good afternoon, Mr. Bean.

9 MR. BEAN: Good afternoon, Your Honors.

10 JUDGE LORIN: Counsel, could you spell your name for the
11 court reporter, please?

12 MR. BEAN: Yes, it's Thomas Bean, B-e-a-n.

13 JUDGE LORIN: And would you introduce your colleagues
14 too, please?

15 MR. BEAN: Yes. Mr. Anand Subramanian and Mr. Jeremy
16 Sterns, each of whom is a co-inventor, and on the current application an
17 Appellant.

18 JUDGE LORIN: And would the spell their names, too, please,
19 for the court reporter?

20 MR. STERNS: That's Jeremy, J-e-r-e-m-y, Sterns, S-t-e-r-n-s.

21 MR. SUBRAMANIAN: Yes. Anand Subramanian. And
22 Anand is spelled A-n-a-n-d. And Subramanian is spelled
23 S-u-b-r-a-m-a-n-i-a-n.

24 JUDGE LORIN: Thank you so much. Welcome.

1 Okay, counsel, we reviewed the record. We're familiar with it.
2 When you're ready, you may proceed. You have 20 minutes.

3 MR. BEAN: Thank you.

4 Will the Examiner be replying today, Your Honor?

5 JUDGE LORIN: No. There will be no Examiner.

6 MR. BEAN: No. Okay. Okay.

7 Well, Your Honors, in our brief of August 5, 2009, Appellants
8 identified two grounds of rejection to be reviewed on appeal, the first being
9 whether Claims 15, 16, 21, 22, and 27 through 29 can be properly rejected
10 under 35 USC Section 103(a) as being obvious over US Patent No.
11 70764432 Emens et al., in view of U.S. Patent No. 58350872 Herz et al.;

12 And the second count as to whether Claim 36 can be rejected
13 under 36 USC 103(a) as being obvious over Emens and Herz in view of the
14 Examiner's official notice.

15 We believe that each of the arguments in our brief merit your
16 attention, but today we'd like to focus on our points 1 and 3 in our brief, with
17 respect to grounds number one.

18 Point one being that Emens fails to teach or suggest the
19 Appellant's claimed invention, which in response to a submission of a URL
20 requesting content by user in an operating station, the requested content is
21 caused to be displayed at the operating station together, with a targeted ad, in
22 direct response to the submission of the URL.

23 And in point 2, that Herz in addition fails to cure the
24 deficiencies of Emens in this regard.

1 Okay. Each of the present Independent Claims, Claims 15, 21,
2 and 89, are directed to an invention, that in response to submission of a URL
3 by a user in an operating station, accesses content by the user targets ads to
4 the content by applying relevancy rules for each of the plurality of ads that
5 are maintained in the ad server, and displays the targeted ads at the station
6 together with the content.

7 And Appellant's submission that Emens teaches a system in
8 which only one of the content in the targeted ads are displayed together at
9 one time.

10 Page 5 of the Examiner's answer of August 29, 2009, the
11 Examiner disagreed with Appellant's position and suggested that Emens
12 teaches the display of content together with a product icon, and that a
13 product icon qualifies as being a targeted advertisement.

14 And it would be our position that a product icon is not a
15 targeted advertisement.

16 Neither our specification or Emen's explicitly defines the term,
17 "advertisement," but we under common meaning would generally take
18 advertisement to mean a notice that's designed to promote a specific
19 identifiable product, service, good, or event, some identifiable item.

20 JUDGE HOMERE: Counsel.

21 MR. BEAN: Yes?

22 JUDGE HOMERE: Doesn't the product icon include the
23 advertisement in there in Emens?

1 MR. BEAN: We believe that it does not. In fact, in column 5,
2 lines 54 through 64 of Emens, Emens actually distinguishes between the
3 terms, "product advertisement" and "product icon."

4 JUDGE HOMERE: Oh --

5 MR. BEAN: Suggesting that they're two distinct items.

6 JUDGE HOMERE: Yeah. But how are they different? How
7 do you get to the advertisement from the product icon?

8 MR. BEAN: In this case, we believe that Emens teaches that
9 you need to click on a product icon, in order to retrieve a list of potential
10 advertisements for view.

11 JUDGE HOMERE: So in other words, by clicking on the
12 product icon, you get access to the advertisement. Right?

13 MR. BEAN: In this case, right, the user must -- upon the user's
14 discretion, click on the icon to obtain access to the advertisement.

15 And we're suggesting in our invention that no discretionary
16 action is required by the user, in that regard.

17 JUDGE HOMERE: Does it preclude that?

18 MR. BEAN: We believe that our claim language, which, for
19 example in Claim 15, with reference to the Matchmaker, which is in the final
20 clause of Claim 15, there is a Matchmaker configured to in response to the
21 submission of the URL by the user at the operating station, access the
22 content received by the user, extract the content according to extracting
23 rules, parse the content of the information into objects, target an ad from the
24 server to the content by applying the relevancy rules and the data stored to

1 the objects, free of information about the user, and directly send the targeted
2 ad to the station for display with the contents.

3 So it's our contention according to the language of the claim
4 that all of those things happen directly in --

5 JUDGE HOMERE: Well, counselor, I mean, I'm not sure
6 that -- I mean, reciting the claim language is helping us out, you know, here.

7 MR. BEAN: Mm-hmm.

8 JUDGE HOMERE: I mean, pretty much you're going over, I
9 mean, you're reading the claim language back to us.

10 What I'm trying to get out of you is: How is it different from
11 what's disclosed in Emens, in the sense that when you click on the product
12 icon, you get access to the ad?

13 So why would that not teach accessing the ad, in response to a
14 search made by the user?

15 MR. BEAN: We're suggesting that the distinction is that
16 Emens teaches that the ad can and will only be accessed with a discretionary
17 action taken by the user, who's viewing the content in this case, or viewing
18 perhaps a precursor to the content in terms of the search results.

19 And we're saying in our claimed invention, the ad is being
20 delivered to the user without any additional selecting step required by the
21 user.

22 JUDGE HOMERE: Does the claim preclude that -- I mean,
23 you didn't answer that part of the question -- preclude the user having the
24 discretion of accessing the ad?

1 Because technically, by clicking on the product icon, you get
2 the ad too, because that's part of the product icon. Right?

3 MR. BEAN: Right.

4 JUDGE HOMERE: Because when you click on that, you get
5 access to the product icon.

6 MR. BEAN: Mm-hmm.

7 JUDGE HOMERE: Okay. So the question is: Does the claim
8 preclude one from discretionarily accessing the ad?

9 JUDGE LORIN: Let me ask the question differently here.

10 You say that the ad and the content need to be delivered
11 together.

12 MR. BEAN: Yes.

13 JUDGE LORIN: And you're distinguishing that over the prior
14 art, because you're saying that the prior art is delivering both content and an
15 icon.

16 MR. BEAN: We're suggesting that the prior art is delivering
17 some content, and an icon, which can be selected -- to produce the ads --

18 JUDGE LORIN: Right --

19 MR. BEAN: But is not delivering them both together for
20 display together.

21 JUDGE LORIN: Is not the ad itself. Is not the ad itself?

22 MR. BEAN: Correct.

23 JUDGE LORIN: Now the question comes up is: Why couldn't
24 the icon itself be the ad?

1 MR. BEAN: It's our belief that according to the procedure
2 taught by Emens, receiving a research results page back, with a number of
3 disparate search results, as you would expect to receive as a response to
4 search results, each of which might be directed to a very different thing,
5 different item, different aspect.

6 And so in recognizing that, what Emens teaches is: Look, the
7 user submitted a search result. What they're really looking for could be one
8 of many different things. What we're going to do is we're going to search
9 through our product ad database to see if we have any ads that might be
10 suitable, in sort of a first pass effort.

11 And for those individual search result items that we think might
12 be matched, for example, in terms of ads having texts that's similar to text in
13 the search result abstracts, we'll place an icon, and then the user, depending
14 on which of those results the user was really interested in, if they're also
15 interested in product results, can select the icon.

16 So the system of Emens is sort of naturally producing a set of
17 icons that may be directed to very, very different kinds of ads, and it is
18 relying on the user to distinguish which search result they're really interested
19 in.

20 So it doesn't seem to us that the icons can be really indicative of
21 a single advertisement, in that case.

22 JUDGE LORIN: Well, the reason I raise this, because your
23 claim calls for the ad --

24 MR. BEAN: Yes --

1 JUDGE LORIN: To display with the content. But the format
2 ad is in isn't limited.

3 MR. BEAN: Correct.

4 JUDGE LORIN: In other words, your ad could be an icon.

5 MR. BEAN: Our ad could be, provided that it conveyed some
6 advertising information.

7 JUDGE LORIN: But that's purely content.

8 MR. BEAN: Right.

9 JUDGE LORIN: In fact, I can see in Figure 7 --

10 MR. BEAN: Mm-hmm --

11 JUDGE LORIN: You've disclosed an ad that's displayed with
12 content. And the ad there is a hyperlink.

13 MR. BEAN: Yes.

14 JUDGE LORIN: It's not mutually exclusive that you're
15 claiming an ad as displayed with the content that the prior art shows content
16 displayed with an icon.

17 MR. BEAN: But we are displaying in our icon, if you
18 will -- I'm not quite sure that I would agree you that that image is simply an
19 icon. It's conveying information about a particular product, I believe, in that
20 case.

21 JUDGE LORIN: Advertisement is content.

22 MR. BEAN: Right.

23 JUDGE LORIN: It's information.

24 MR. BEAN: Okay.

1 JUDGE LORIN: The form in which that information is in, isn't
2 limited in your claim. It could be an icon.

3 MR. BEAN: It could be, but the icon would need to convey
4 advertising.

5 JUDGE MOHANTY: Yeah, well, an icon can be a simple
6 picture, correct?

7 MR. BEAN: Correct.

8 JUDGE MOHANTY: And so if I have a small icon of like
9 McDonald's arches or something like that --

10 MR. BEAN: Mm-hmm --

11 JUDGE MOHANTY: Isn't that picture conveying content?

12 MR. BEAN: Well, our understanding of Emens is that the
13 initial icon is produced on sort of a first pass through upon determining that
14 there's at least a single ad that may be associated with a search result item,
15 and that upon selection, if a user selects the icon, then the system of Emens
16 goes back and does a complete search of its ad database, provides a listing of
17 all ads, which may reference many products.

18 So it seemed to us unlikely that in that case, where that icon
19 could be simply a reference to a list of many different products, each of
20 which would be associated with individual advertisements, but the icon itself
21 could convey any advertising information, because it was representative of
22 the many items in the list.

23 JUDGE LORIN: We understand that the prior art is going from
24 the icon and adding a further step of retrieving information about products --

25 MR. BEAN: Mm-hmm --

1 JUDGE LORIN: That correspond to the icon. And Judge
2 Homere raised the fact that that particular additional step is not precluded by
3 your method.

4 MR. BEAN: It's not precluded, but our method, I believe in
5 this case, requires that the advertisement be delivered without that additional
6 step.

7 JUDGE LORIN: Right. We're going a little bit in circles here.

8 MR. BEAN: Right.

9 JUDGE LORIN: And what we're saying is: Why can that
10 advertisement be the icon as disclosed in the prior art?

11 MR. BEAN: I'm sorry, Judge. Could you --

12 JUDGE LORIN: Now I understand your position is that even
13 though you do not limit your ad to not being an icon, you're arguing that the
14 icon in Emens --

15 MR. BEAN: Is not an advertisement.

16 JUDGE LORIN: Is not an advertisement.

17 MR. BEAN: Correct.

18 JUDGE LORIN: All right. Thank you, counsel.

19 MR. BEAN: Okay. Thank you.

20 Okay. Sir, further picking up on some of those points, in the
21 Examiner's answer, the Examiner suggested that we had made an argument
22 that in Emens the user has to click on the icon. And in our invention, the
23 user's not required to do that, and that that particular aspect, the feature
24 wasn't recited in the claim language.

1 And our position in response to that is that what we're really
2 referring to is the fact, in particular with respect to Independent Claims 15
3 and 89, that we have the requirement that the advertisement be directly sent
4 to the user operating station, in response to the submission of the URL,
5 without the click.

6 And so we're not -- you know, we're not asserting that we
7 don't -- particularly that we don't have to click, but that the ad is coming to
8 the user station without any additional intervention on the part of the user.

9 Okay. So that is --

10 JUDGE HOMERE: What -- say that? What intervention? You
11 just said that --

12 MR. BEAN: We say directly, directly to the user, within that
13 file --

14 JUDGE HOMERE: Without intervention from the user?

15 MR. BEAN: It does not say specifically without intervention.
16 Because our interpretation of --

17 JUDGE HOMERE: Are you reading that into the claim now?

18 MR. BEAN: It's our interpretation of the term, "directly."

19 JUDGE HOMERE: Meaning without intervention?

20 MR. BEAN: Right. It's our interpretation of this claim
21 element, that all of these things are happening as a consequence of the
22 submission of the URL.

23 JUDGE HOMERE: Without user intervention?

24 MR. BEAN: Without user intervention.

1 JUDGE HOMERE: Albeit the claim doesn't say that?

2 Although that's explicitly recited in the claim by --

3 MR. BEAN: Right, I think it was our intention to make that
4 limitation from the vantage point of the term, "directly" in the claim.

5 Okay.

6 And just in terms of considering -- and we've discussed this also
7 to some extent already -- sort of the significance and why one would not
8 proceed, for example, on the basis of Emens, of thinking about providing an
9 advertisement directly to user and operating station, as a result of producing
10 the search results, we think that teaching the system of Emens really doesn't
11 lend itself to that sort of result, again because of the fact that Emens is
12 forming a search query that produces multiple search results, which may be
13 very, very distinct;

14 And as far as we can tell, in terms of ad identification, relying
15 on the matching of terms in the search result abstracts to terms and language
16 in the advertisements themselves, as is disclosed in Claim 1 of Emens.

17 And so we think that Emens would effectively teach away from
18 our result, in which we are suggesting that an appropriate ad can be
19 delivered simply by analyzing and parsing the language of the content of the
20 URL to identify objects in the manner that we disclose in our application.

21 And I guess in particular, although not within the scope of the
22 Independent Claims 15, 21, and 89, one of the reasons that we believe that
23 we're able to successfully do that is because in the object analysis that is
24 performed by our invention, we're actually looking to perform a textual

1 analysis that is based on structural key words, for example, as we claim in
2 Claim 29.

3 And this is able to give us more precision than a simple textual
4 search would provide, and enable us to be able to find an appropriate ad
5 without this additional user intervention to produce it.

6 Yes?

7 JUDGE LORIN: Do you have any more comments about
8 Claim 15?

9 MR. BEAN: No, sir.

10 JUDGE LORIN: I have a question about Claim 36. I know you
11 were going to rest on your brief. But I'm a little confused about what has
12 happened here.

13 The rejection of Claim 36 involves something that's well
14 known. Correct? That's part of the prior art the Examiner applied?

15 MR. BEAN: The Examiner suggested that it was well known
16 in the prior art. And we had, I guess, requested during the prosecution a more
17 explicit reference, because it wasn't clear to us that it was known.

18 JUDGE LORIN: Well, that's exactly my question.

19 MR. BEAN: Yeah.

20 JUDGE LORIN: That did happen during prosecution? You
21 had asked for evidence?

22 MR. BEAN: Yes

23 JUDGE LORIN: To support that?

24 MR. BEAN: Yes.

1 JUDGE LORIN: And the Examiner's maintained -- the
2 Examiner's never provided evidence to support that. Is that true?

3 MR. BEAN: It is our belief and understanding that the
4 Examiner did not provide further evidence to us to support the fact that that
5 was well known.

6 JUDGE LORIN: But you did raise it during prosecution, before
7 the final objection?

8 MR. BEAN: Yes. Yeah, I --

9 JUDGE MOHANTY: It was their point that you didn't make
10 the proper traversal?

11 MR. BEAN: Hmm --

12 JUDGE MOHANTY: What were their reasons for not
13 providing the reference?

14 MR. BEAN: Not that I'm aware of, Your Honor. Frankly, I
15 would have to go back and look at the record a little bit more closely. I'm
16 not sure what -- I know we made the request, and I'm not sure what
17 happened.

18 JUDGE LORIN: And we're a bit confused why the Examiner
19 didn't follow up, based on your request. I'm sure you are too.

20 MR. BEAN: Yes.

21 JUDGE LORIN: Okay.

22 Any further questions?

23 JUDGE HOMERE: Well, I have one last question.

1 On page 7 of the Examiner's answer, the Examiner says that
2 applicants need to provide a proper challenge that would at least cast
3 reasonable doubt on the fact taken notice of.

4 Do you have any opinion about that?

5 MR. BEAN: Yeah. I think it was our opinion at the time of the
6 rejection during prosecution that it was our right under, I think it was a Rule
7 104, to simply ask for some sort of reference, with respect to what the
8 Examiner suggested, it was commonly known knowledge.

9 JUDGE LORIN: Okay. Thank you very much.

10 MR. BEAN: Thank you very much, Your Honors.

11 JUDGE LORIN: Thank you.

12 Whereupon, at 2:26 p.m. the proceedings were concluded.

13

14